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10/781,470

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Atsushi Shibutani

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EXAMINER

AGGARWAL, YOGESH K

ART UNIT

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2622

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/781,470

**Applicant(s)**

SHIBUTANI, ATSUSHI

**Examiner**

Yogesh K. Aggarwal

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 02/17/2004.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_.

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***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

2. Claim(s) 10-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claims 10-12 define a storage medium embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" – Guidelines Annex IV). That is, the scope of the presently claimed recording medium having a storage medium can

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range from paper on which the program is written, to a program simply contemplated and memorized by a person.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 4, 5, 6, 7, 8, 10 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Ban (US PG-PUB # 2004/0201741).

[Claim 1]

Ban teaches a camera apparatus (figure 3) comprising:

a display device (LCD display 3) for displaying in a standby state for taking a picture an optical image of a subject to be photographed (Paragraphs 131, 133 teach live view image which is an optical image in the standby state along with sample image GS {labeled in figure 6 and paragraph 89}, Also see Paragraph 129 and figures 17 and 19);

a memory (figure 3, memory 48) for storing photographing condition data (e.g. a macro mode, person mode, and sport mode as taught in Paragraphs 89, 90 and 94) for setting a photographing condition (e.g. a shutter speed, a state of diaphragm corresponding to a particular mode) for the camera apparatus, sample images (e.g. sample image GS as shown in figure 6 and in figures 15-18) each for indicating an image of the subject corresponding to the photographing condition data (See a detailed guide information explanation in Paragraphs 80-95 and figures 4-

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7), and additional information data (guide information GT shown in figure 6 and Paragraph 89 and in figures 16-18) for explaining the photographing condition (correspond to a mode and photographing condition e.g. shutter speed, a state of diaphragm) and contents of the sample image (Paragraphs 126-130, figures 14-18);

a selector (touch panel sensor 17) for selecting one of the sample images stored in the memory 48 in response to a selecting operation (Paragraphs 90 and 135, figures 6, 15 and 16);

a photographing-condition setting unit (microcomputer 50) for setting the photographing condition (e.g. a shutter speed, a state of diaphragm corresponding to a particular mode) based on the photographing condition data (e.g. a macro mode, person mode, and sport mode as taught in Paragraphs 89, 90 and 94) corresponding to the sample image (GS) selected by the selector (Paragraph 90); and

a display controller (51) for causing the display device to display the sample image selected by the selector together with the optical image of the subject in the standby state for taking a picture (Paragraphs 131, 133 teach live view image which is an optical image in the standby state along with sample image, Also see Paragraph 129 and figures 17 and 19).

[Claim 2]

Ban teaches wherein the display controller (51) causes the display device to display the sample images stored in the memory one by one sequentially together with the optical image of the subject for selection by the user (Paragraphs 135 and figures 17 and 19), and the photographing-condition setting unit (microcomputer 50) sets fresh photographing condition corresponding to the sample image newly selected by the user in place of the previously set photographing condition (Paragraphs 90, 91, 135-140, figures 4-7, It is noted that different guide information

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units will set fresh photographing conditions corresponding to the sample image, guide information and the particular mode selected).

[Claim 4]

Ban teaches a camera apparatus (figure 3) comprising:

a display device (LCD display 3) for displaying in a standby state for taking a picture an optical image of a subject to be photographed (Paragraphs 131, 133 teach live view image which is an optical image in the standby state along with sample image GS labeled in figure 6 and paragraph 89, Also see Paragraph 129 and figures 17 and 19);

a memory (figure 3, memory 48) for storing photographing condition data (e.g. a macro mode, person mode, and sport mode as taught in Paragraphs 89, 90 and 94) for setting a photographing condition (e.g. a shutter speed, a state of diaphragm corresponding to a particular mode) for the camera apparatus, sample images (e.g. sample image GS as shown in figure 6 and in figures 15-18) each for indicating an image of the subject corresponding to the photographing condition data (See a detailed guide information explanation in Paragraphs 80-95 and figures 4-7), and additional information data (guide information GT shown in figure 6 and Paragraph 89 and in figures 16-18) for explaining the photographing condition (correspond to a mode and photographing condition e.g. shutter speed, a state of diaphragm) and contents of the sample image (Paragraphs 126-130, figures 14-18);

a selector (touch panel sensor 17) for selecting one of the sample images stored in the memory 48 in response to a selecting operation (Paragraphs 90 and 135, figures 6, 15 and 16);

a photographing-condition setting unit (microcomputer 50) for setting the photographing condition (e.g. a shutter speed, a state of diaphragm corresponding to a particular mode) based on

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the photographing condition data (e.g. a macro mode, person mode, and sport mode as taught in Paragraphs 89, 90 and 94) corresponding to the sample image (GS) selected by the selector (Paragraph 90); and

a display controller (51) for causing the display device to display the additional information explaining the contents of the sample image selected by the selector together with the optical image of the subject in the standby state for taking a picture (Paragraphs 131, 133 teach live view image which is an optical image in the standby state along with sample image, Also see Paragraph 129 and figures 17 and 19).

[Claim 5]

Ban teaches wherein the display controller (51) causes the display device (3) to display the plural pieces of additional information stored in the memory sequentially together with the optical image of the subject for selection by the user (Paragraphs 135 and figures 17 and 19), and the photographing-condition setting unit (microcomputer 50) sets fresh photographing condition corresponding to the additional information newly selected by the user in place of the previously set photographing condition (Paragraphs 90, 91, 135-140, figures 4-7, It is noted that different guide information units will set fresh photographing conditions corresponding to the sample image and guide information selected).

[Claim 6]

Ban teaches wherein the display controller 51 causes the display device 3 to simultaneously display plural pieces of additional information to be selected by the user together with the optical image of the subject (Figures 17 and 19 clearly teach plural pieces of information that is selected by the user together with the live view image).

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[Claims 7,8,10,11]

These are method and computer program claims corresponding to apparatus claims 1 and 2 and are therefore analyzed and rejected based upon apparatus claims 1 and 2 respectively.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ban (US PG-PUB # 2004/0201741) in view of Matsugu et al. (US Patent # 6,987,535).

[Claim 3]

Ban fails to teach wherein the display controller causes the display device to simultaneously display plural sample images to be selected together with the optical image of the subject.

However Matsugu teaches multiple extracted images (40a-40c, sample images) that are displayed simultaneously on the display (24) together with the optical image of the object (background object 42, col. 4 line 15-col. 5 line 51, figures 2-4).

Therefore taking the combined teachings of Ban and Matsugu, it would be obvious to one skilled in the art to have been motivated to have display controller causes the display device to simultaneously display plural sample images to be selected together with the optical image of the subject to be used in the system of Ban in order for the user to look at multiple images at the same time and choose the best image from among the plurality of sample images thereby having a final image according to user's tastes and best quality.



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[Claims 9 and 12]

These are method and computer program claims corresponding to apparatus claim 3 and is therefore analyzed and rejected based upon apparatus claim 3.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh K. Aggarwal whose telephone number is (571) 272-7360. The examiner can normally be reached on M-F 9:00AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lin Ye can be reached on (571)-272-7372. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YKA  
July 22, 2007

